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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,317	10/20/2000	Kia Silverbrook	ART85US	8404
24011	7590	05/04/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			POON, KING Y	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/693,317	SILVERBROOK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	King Y. Poon	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunoshita (6,603,864) in view of Soscia (US 5,996,893).

In accordance with claim 1, Matsunoshita discloses an apparatus 52 (figure 20) of reading digital data (e.g., bar codes, column 17, lines 50-60, additional data, column 18, lines 1-20) including encoded image data (bar code, inherently, is encoded image data) printed on a printed media in invisible ink (column 17, lines 53).

Matsunoshita further discloses that the apparatus includes a scanner means 57 for scanning in the invisible ink data (encoded image data) on the printed media (col. 18 lines 8-9, note; a scanner system such as the system of Matsunoshita is a camera system, that used to create the bar code, column 17, lines 19-27).

Matsunoshita further discloses that the apparatus includes means for advancing the print media through the scanner means and means for illuminating the print media with invisible radiation (col. 17 lines 51-65).

Matsunoshita further discloses that the apparatus includes means 55 for processing the data output from said scanner means including means for decoding said

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data; in Matsunoshita's system, the scanner means 57 detects infrared data on the image and the embedding unit 55 processes the data output from the scanner means 57 for decoding and sends it to the personal computer (col. 18 lines 14-18).

Matsunoshita further discloses that the apparatus includes ink jet printer means for printing out the image derived from said decoded data on a print media attached to said ink jet means, in Matsunoshita's system, print 51 uses 5 inks to print the images YMCK and IR toner (col. 16 lines 62-65).

Matsunoshita does not teach the print media is a photograph with printed invisible digital data. However, scanning a photograph is inherent properties of a scanner.

Soscia, in the same area of printing and scanning invisible image on a printed media (column 1, lines 40-45, column 5, lines 30-40, column 6, lines 60-65), teaches scanning a photograph (column 1, lines 40-45) printed with digital images (column 5, lines 30-40, column 6, lines 60-65).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the print media of Matsunoshita to include a photographs with digital data printed in invisible ink.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the print media of Matsunoshita by the teaching of Soscia because of the following reasons: (a) since digital camera becomes more popular, it is desirable of creating photographs having digital data printed with invisible ink, column 1, Soscia; and (b) it would have allowed Matsunoshita's system to

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be widely used by users of digital camera without any modification to the system of Matsunoshita.

In accordance with claim 4, Matsunoshita discloses that the printer 51 embeds the data printed in IR ink into the image printed from the image data (col. 16 lines 4-6 and 8-9).

In accordance with claim 3, Matsunoshita discloses using IR ink as the invisible ink (col. 16 line 6).

3. Claims 2, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunoshita (6,603,864) in view of Soscia (US 5,996,893) as applied to claim 1 above, and further in view of Zhang (US 5,771,245).

In accordance with claims 2 and 5, Matsunoshita does not disclose expressly that the image data is encoded and decoded using the Reed-Solomon process.

Zhang discloses using the Reed-Solomon process to encode/decode data (col. 4 lines 18-20).

Matsunoshita and Zhang are combinable because they are from the same field of endeavor, namely two-dimensional data encoding and decoding.

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to use the Reed-Solomon process, as taught by Zhang, as the encoding/decoding process in Matsunoshita's system.

The motivation for doing so would have been that the Reed-Solomon process is a well-known process in the art to protect encoded data (Zhang: col. 4 lines 18-20).

***Response to Arguments***

4. Applicant's arguments filed on 1/24/2005 have been fully considered but they are not persuasive.

With respect to applicant's argument that the examiner has stated that Matsunoshita specifically teaches encoding and decoding bar codes and copy right information and has conceded that Matsunoshita does not teach the encoding of image data such that the image can be reproduced from the encoded data.

In reply: The applicant is right that the examiner has stated that Matsunoshita specifically teaches encoding and decoding bar codes.

Examiner has not conceded that Matsunoshita does not teach the encoding of image data such that the image can be reproduced from the encoded data; the Examiner states that Matsunoshita does not disclose expressly the encoding of image data bottom of page 3, top of page 4, office action mailed 12/1/2004.

Claim 1 is claiming "digital data" being printed on a photograph, the photograph including "an image." In other words, the photograph has "printed digital data" and "an image." The examiner states that Matsunoshita specifically teaches encoding and decoding bar codes which is the "printed digital data" and does not teach encoding the "an image." The amended claim clarifies that the encoding is for the "printed digital

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data" and not the "an image." The examiner maintained that Matsunoshita specifically teaches encoding the "printed digital data" as previously stated.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (571) 272-7440

April 30, 2005



**KING Y. POON  
PRIMARY EXAMINER**